

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the following discussion, is respectfully requested.

Claims 39-61 are pending. Claims 41, 42, 48, 55, and 56 were previously withdrawn. As no amendments are hereby made to the application, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claim 45 is rejected under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Honda (U.S. Patent No. 4,589,432); Claims 39, 40, 43, 44, 51-54, 57, and 58 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgson (U.S. Patent No. 3,645,835); Claims 45, 46, 50, and 61 were rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin (U.S. Patent No. 4,653,483); Claim 47 was rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin in view of Samuelsen et al. (WO 99/38929, hereinafter “Samuelsen”); Claim 49 was rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin in view of Hodgson; and Claims 59 and 61 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgson in view of Berglund et al. (U.S. Patent No. 4,310,509, hereinafter “Berglund”).

In response to the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a), Applicant respectfully requests reconsideration of these rejections and traverses these rejections, as discussed below.

Independent Claim 45 recites, in part, a double eyelid forming article of manufacture for forming a fold on an eyelid of a user, comprising:

a resiliently stretchable elongate string member configured to adhere to the eyelid in a stretched state along a longitudinal direction, wherein the string member in the stretched state is configured to have a resilient shrinkability larger than a tension of skin on the eyelid and also has a sufficient width and a sufficient length such that the string member is configured to form the fold on the eyelid by

adhering to the eyelid while the string member is in the stretched state and subsequently recoiling back toward an unstretched state due to the resilient shrinkability to form a double eyelid.

Accordingly, the double eyelid forming article of manufacture is for forming the double eyelid on a user. Such a double eyelid forming article adheres to the eyelid and thus is completely different from other articles used for other medical purposes and for general cosmetic purposes. Accordingly, it is respectfully submitted that the cited references do not disclose or suggest every feature recited in Claim 45.

Honda describes an eyelash permanent curl setting rod 1 including a rod member 2 and an adhesive layer 3 on a periphery of the rod member 2.¹ Further, Honda describes that the rod member 2 can be made of plastic, rubber or wood and that the rod member 2 can be an elastic material.²

However, it is respectfully submitted that Honda does not disclose or suggest “a resiliently stretchable elongate string member configured to adhere to the eyelid in a stretched state along a longitudinal direction, wherein the string member in the stretched state is configured to have a resilient shrinkability larger than a tension of skin on the eyelid and also has a sufficient width and a sufficient length such that the string member is configured to form the fold on the eyelid by adhering to the eyelid while the string member is in the stretched state and subsequently recoiling back toward an unstretched state due to the resilient shrinkability to form a double eyelid,” as recited in Claim 45.

Instead, the rod member 2 described in Honda adheres to leading ends of eyelashes such that the eyelashes are curled around the rod member 2 which is then adhered to the eyelid of the user.³ Thus, although Honda describes that the rod 1 includes an elastic rod member 2 and an adhesive 3, Honda does not disclose or suggest that the adhesive 3 is strong

¹ See Honda, at column 2, lines 18-23 and in Figure 1.

² See Honda, at column 2, lines 28-39.

³ See Honda, at column 3, lines 3-15.

enough to hold on to the skin when the stretched rod 1 is attached to the skin and then allowed to recoil back to an unstretched state. Instead, Honda only describes that the adhesive 3 is strong enough to hold on to the eyelash and the eyelid in an unstretched state.

Further, Honda also does not disclose or suggest that the elastic material of the rod 1 described in Honda has a resilient shrinkability larger than a tension of the skin on the eyelid as Honda does not disclose or suggest stretching the rod 1 and then attaching the rod 1 to the eyelid. Although the Office Action in section 10 takes the position that “it is reasonable to presume that Honda’s string member is functionally capable of meeting the aforementioned claimed features,” the Office Action does not provide any evidence for such a statement. Specifically, the rod member 1 can perform its intended function (curling an eyelash) without having the structural configuration to perform any of the functions of the claimed double eyelid forming article.

Additionally, as the relationship between the resiliency of the string member and the strength of the adhesive of the claimed article are not disclosed or suggested in Honda, it is respectfully submitted that the rod 1 of Honda does not have the same structural configuration of that recited in Claim 45. Specifically, although the Office Action states that “Honda’s string member is formed of resiliently stretchable material such as rubber and it is covered with an adhesive,” the elastic material described in Honda does not inherently have a resilient shrinkability larger than a tension of the skin on the eyelid and the adhesive 3 is not inherently strong enough to hold on to the skin of the eyelid when such shrinking occurs.

Accordingly, it is respectfully submitted that Honda does not disclose or suggest every feature recited in Claim 45. Thus, it is respectfully requested that the rejection of Claim 45 as anticipated by or, in the alternative, as unpatentable over Honda be withdrawn.

Hodgson describes a surgical drape including a backing material 2 and an adhesive 4.⁴ Further, Hodgson describes that the surgical drape may also be used for other purposes such as applying cosmetics or to produce a wrinkle in the skin.⁵ However, it is respectfully submitted that Hodgson does not disclose or suggest “a resiliently stretchable elongate tape member configured to adhere to the eyelid in a stretched state along a longitudinal direction, wherein the tape member in the stretched state is configured to have a resilient shrinkability larger than a tension of skin on the eyelid and also has a sufficient width and a sufficient length such that the tape member is configured to form the fold on the eyelid by adhering to the eyelid while the tape member is in the stretched state and subsequently recoiling back toward an unstretched state due to the resilient shrinkability to form a double eyelid,” as recited in Claim 39.

Instead, although Hodgson describes producing a wrinkle on skin, Hodgson is silent with respect to producing a double eyelid on the skin of an eyelid. Further, the surgical drape described in Hodgson can produce a wrinkle for example, on a forearm, without producing a double eyelid on the skin of the eyelid. Thus, Hodgson does not inherently have the same structural properties of resilient shrinkability and adhesiveness that the claimed double eyelid forming article does. Although the Office Action in section 13 takes the position that the surgical drape of Hodgson “is functionally capable of meeting the aforementioned recitations,” Applicant respectfully disagrees with this assertion. On the contrary, as discussed above, the surgical drape described in Hodgson is capable of performing all of the functions described in Hodgson without being functionally capable of meeting the recitations of Claim 39. Further, although the Office Action repeatedly cites portions of Hodgson which

⁴ See Hodgson, at column 10, lines 27 and 28 and in Figure 7.

⁵ See Hodgson, at column 10, lines 32-40.

describes using the device therein as a surgical drape, the Office Action has not provided any evidence that such a surgical drape can form a double eyelid on the skin of an eyelid.

Accordingly, it is respectfully submitted that Hodgson does not disclose or suggest every feature recited in Claim 39. Thus, it is respectfully requested that the rejection of Claim 39, and all claims dependent thereon, as unpatentable over Hodgson be withdrawn.

Further, independent Claims 45 and 51, while directed to alternative embodiments, each recite features similar to those discussed above with respect to Hodgson. Thus, it is also respectfully requested that the rejection of Claims 45 and 51, and all claims dependent thereon, as unpatentable over Hodgson be withdrawn.

Clavin describes an adhesive strip 32 configured to hold the skin of the upper eyelid 10 which is pulled gently down over the adhesive strip 32 to reduce bagging of the upper eyelid 10.⁶ Accordingly, the adhesive strip 32 described in Clavin is first placed on the eyelid 10, and then a user folds the eyelid 10 over the adhesive strip 32.

However, it is respectfully submitted that Clavin does not disclose or suggest “a resiliently stretchable elongate string member configured to adhere to the eyelid in a stretched state along a longitudinal direction, wherein the string member in the stretched state is configured to have a resilient shrinkability larger than a tension of skin on the eyelid and also has a sufficient width and a sufficient length such that the string member is configured to form the fold on the eyelid by adhering to the eyelid while the string member is in the stretched state and subsequently recoiling back toward an unstretched state due to the resilient shrinkability to form a double eyelid,” as recited in Claim 45.

Instead, Clavin is silent with regard to first stretching the tape, and then allowing the resilient shrinkability to overcome the tension of the skin of the eyelid to form a double eyelid as the tape returns to its original size. As discussed above, Clavin merely describes

⁶ See Clavin, at column 4, lines 26-35 and in Figures 6-9.

that the adhesive strip 32 is placed on the eyelid 10 and then the user folds the eyelid 10 on to the adhesive strip 32. Thus, although Clavin describes that the adhesive strip 32 can be formed of polyethylene, it is noted that there are many different types of polyethylene with different structural properties such that the adhesive strip 32 does not inherently have resilient shrinkability larger than a tension of the skin. Further, as noted above, the adhesive strip 32 can perform all of the functions required by Clavin without having the claimed resilient shrinkability.

Independent Claim 45 also recites that “the individual side edges of the first surface and the second surface are each in linear forms in parallel to each other along the whole longitudinal direction of the string member when the string member is in the unstretched state, cross sections of the first surface and the second surface perpendicular to the longitudinal direction of the string member each have outwardly protruding arcuate shapes along the entire longitudinal direction of the string member when the string member is in the unstretched state, the cross sections each have a uniform form along the whole longitudinal direction of the string member when the string member is in the unstretched state.”

The Office Action in section 27 takes the position that the above-quoted elements in Claim 45 are disclosed in Figures 13 and 15 of Clavin or are an “obvious optimization to one of ordinary skill in the art, motivated by the desire to produce a string member that can be suitably applied to eyelids.” Applicant respectfully traverses this assertion.

On the contrary, in the double eyelid forming product of the type to simply stick as described in Clavin, it is necessary to stick the tape to the eyelid along the three-dimensional shape of the eyeball. Thus, a curve of at least a portion of the side edges is an indispensable requirement in Clavin and the tape with linear side edges entirely parallel to each other is not a part of the double eyelid forming product. Accordingly, a person of ordinary skill in the art

reading Clavin would not find it obvious to optimize the adhesive strip 32 to have the claimed dimensions.

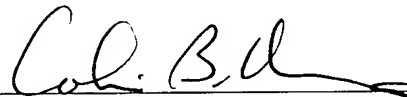
Therefore, it is respectfully submitted that Clavin does not disclose or suggest every feature recited in independent Claim 45. Thus, it is respectfully requested that the rejection of Claim 45, and all claims dependent thereon, as unpatentable over Clavin be withdrawn.

Turning now to the rejections of Claims 47, 49, 59, and 61, it is noted that these claims are dependent on independent Claims 39, 45, and 51. Accordingly, these claims are believed to be patentable for at least the reasons discussed above with respect to Claims 39, 45, and 51. Further, it is respectfully submitted that none of the secondary references (Samuelson, Hodgson, and Berglund) cure the above-noted deficiencies of Clavin and Hodgson. Thus, it is respectfully requested that the rejections of Claims 47, 49, 59, and 61 be withdrawn.

Consequently, in view of the above discussion, no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

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